

REMARKS

Upon entry of the present amendment, claim 10 will have been amended to improve the language and the consistency thereof with the claim from which it depends. In view of the herein contained remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections set forth in the above-mentioned Official Action. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants point out that the present application contains 10 claims rather than the 8 indicated on the cover sheet (PTOL-326) and treated in the Official Action. Claims 9 and 10 were submitted in the Response filed in the present application on April 13, 2005 to which the outstanding Official Action is indicated to be responsive.

In the outstanding Official Action, the Examiner indicated the acceptance of Fig. 11. The Examiner is respectfully thanked for indicating approval of this drawing figure.

Additionally, in the Response filed on April 13, 2005, Applicants respectfully requested that the Examiner forward a copy of the PTO-1449 Form that was attached to the Information Disclosure Statement filed on October 22, 2003, receipt of which was confirmed in the previous Office Action. However, a copy of this Form has not yet been received by Applicants. Accordingly, Applicants again respectfully request that the Examiner provide a copy of the signed, initialed PTO-1449 Form confirming consideration of the documents cited in the Information Disclosure Statement of October 22, 2003.

Further, Applicants again note that an additional Information Disclosure Statement was filed in the present application on December 6, 2004. This Information

Disclosure Statement submitted, for consideration by the Examiner, a copy of the European Search Report together with copies of the foreign documents cited therein. Applicants again respectfully request that the Examiner consider these documents and confirm such consideration by initialing, signing and attaching a copy of the PTO-1449 Form attached thereto to the next Official Action in the present application. Applicants submit that such consideration is appropriate and proper in view of the fact that the above-noted Information Disclosure Statement was filed prior to the issuance of an action on the merits in the present application.

Applicants note with appreciation the Examiner's indication that the present application claims priority of June 20, 1997. However, Applicants respectfully request that the Examiner confirm that the certified copy of the Japanese Application 9-180528 that was filed on June 20, 1997 and which forms the basis for Applicants' Claim for Priority was filed in the parent application. Such action is believed to be appropriate and proper and is respectfully requested.

Turning to the outstanding Official Action, the Examiner noted that Applicants arguments have been considered by are not persuasive to overcome the double patenting rejection. The Examiner again rejected claims 1-8 under the judicially created doctrine of double patenting over claims 1-9 of U.S. Patent No. 6,618,749.

Applicants respectfully traverse the above rejection and submit that it is inappropriate, at least because in the last Response, Applicants submitted an executed Terminal Disclaimer.

Moreover, it is respectfully submitted that at least for each of the reasons set forth in the Response filed on April 13, 2005, the Examiner's double patenting rejection

is inappropriate. As can be seen from the Examiner's comparison of the respective claims, the ('749) patent relates to an Internet transmission apparatus including a transmitter while the present application relates to a facsimile apparatus that receives e-mail data and includes an e-mail receiver. Thus, from the outset, the two claims are directed to different devices, one claim to a transmitter and the other claim to a receiver. This is merely one example of the numerous distinctions set forth in the Response filed on April 13, 2005.

Nevertheless, in order to resolve the Examiner's concerns, Applicants filed, attached to the Response of April 13, 2005, an executed Terminal Disclaimer with respect to U.S. Patent No. 6,618,749.

However, as noted in the above-noted Response, since there are adequate and sufficient reasons for the impropriety of the Examiner's double patenting rejection, the Terminal Disclaimer was filed only as a convenience to the Examiner and only so as to expedite the progress of the present application towards allowance.

Further, the filing of the Terminal Disclaimer on April 13, 2005 is not to be interpreted as an acquiescence, on the part of either Applicants or the Assignee of the present application, that in the absence of the filing of a Terminal Disclaimer, any double patenting rejection would be inappropriate. Rather, as noted in both the present Response as well as in the Response filed on April 13, 2005, the Terminal Disclaimer is being filed merely in order to expedite the allowance of the claims in the present application.

In the outstanding Official Action, the Examiner rejected claims 1-8 under 35 U.S.C. § 103 as obvious over ISHIBASHI et al. (U.S. Patent No. 6,374,291) in view of

FUJITA et al. (U.S. Patent No. 6,023,716). Applicants respectfully traverse the above rejection and submit that it is inappropriate.

Applicants invention is directed to an Internet facsimile apparatus that receives e-mail data and is connected to a computer network. The Internet facsimile apparatus of the present invention includes an e-mail receiver that receives e-mail data transmitted via the computer network. The e-mail data includes a header, document information and image information. The present invention also includes a determiner that determines whether or not the document information contains predetermined data indicating that the e-mail data was transmitted from an Internet facsimile apparatus. Further, the present invention includes a printer that prints the entire received e-mail data when the determiner determines that the document information does not contain the predetermined data and that prints the image information when the determiner determines that the document information contains the predetermined data.

Thus, as a result of the combination of features recited, e.g., in Applicants claim 1, the Internet facsimile apparatus according to the present invention will print either the entire received e-mail data or only the image information portion of the e-mail data depending on whether or not the e-mail data was transmitted from an Internet facsimile apparatus. It is respectfully submitted that the combination of features recited in Applicants claims are not taught, disclosed nor rendered obvious by any of the references or record in the present application, in any proper combination. In particular, it is respectfully submitted that the combination of features recited in Applicants claims are not taught, disclosed nor rendered obvious by the combination of ISHIBASHI et al. and FUJITA et al. asserted by the Examiner.

In setting forth the rejection, the Examiner asserted that the determiner is provided in the changing of image data to e-mail format as set forth at column 6, line 60 through column 7, line 10. Applicants respectfully traverse the Examiner's assertion and respectfully point out that this portion of the ISHIBASHI et al. reference contains no disclosure regarding determining whether or not the document information contains predetermined data indicating that the e-mail data was transmitted from an Internet facsimile apparatus. Rather, this portion of ISHIBASHI et al. merely discloses that since image data cannot be directly transmitted through the Internet, it is changed to electronic mail format by attaching a Class F Header information of TIFF to the top of the G3 format image data and the TIFF image data produced thereby is converted to text data at a binary text conversion part 23 in step S7. However, no portion of ISHIBASHI et al. discloses a determiner as recited in Applicants claims.

The Examiner's assertion regarding the printer of ISHIBASHI et al. is also asserted to be inappropriate and in error. While ISHIBASHI et al. does disclose a printer, since there is no indication that ISHIBASHI et al. determines whether or not the document information contains or does not contain predetermined data, the printer cannot print only the image portion when it is determined that the document information contains the predetermined data. Thus, all that ISHIBASHI et al. discloses is a printer that records image data received from a facsimile device or from the Internet. This, however, is not what Applicants claim requires.

The Examiner's reliance upon FUJITA et al. is also submitted to be in error. FUJITA et al. merely discloses that a printer can be controlled to print selected portions

of data. In particular, FUJITA et al. discloses keys 44 and 45 (Fig. 3) which can be used to manually designate areas to be printed.

There is, however, no disclosure in FUJITA et al. of printing in response to a determination by a determiner as recited, e.g., in Applicants claim 1. Accordingly, since neither ISHIBASHI et al. nor FUJITA et al. disclose each of the features recited in Applicants claims, the combination thereof can also not disclose the combination of features recited in Applicants claims. In particular, neither of the references discloses a determiner as recited or a printer as recited.

Applicants further wish to make of record a telephone interview conducted on August 10, 2005 between Applicants undersigned representative and Examiner Vu who is in charge of the present application. Initially, Applicants representative respectfully thanks Examiner Vu for his cooperation in scheduling and conducting the above-noted interview.

During the above-noted interview, Applicants undersigned representative explained the various features of the present application and pointed out the significant shortcomings of the references with respect to the features recited in Applicants claims. In this regard, Applicants representative pointed out that the primary reference does not disclose a determiner as recited in the pending claims. Applicants noted that ISHIBASHI et al. merely discloses that image data is changed to e-mail format but there is no determination in ISHIBASHI et al. of whether or not the document information contains predetermined data indicating that the e-mail data was transmitter from an Internet facsimile apparatus.

Applicants also addressed the shortcomings of the secondary reference. In this regard, Applicants pointed out that FUJITA et al. does not teach printing as recited in Applicants claims. In particular, Applicants pointed out that FUJITA et al. does not teach printing an entire received e-mail data when it is determined that the document information does not include the predetermined data and also does not disclose printing only image information when it is determined that the document information contains the predetermined data. Applicants pointed out that FUJITA et al. merely discloses that by manual operation of specific keys as shown, for example, in Fig. 3, specific parts of an image can be printed.

Applicants also noted FUJITA et al. does not teach printing of either a whole or a part of an e-mail data based on a determination. FUJITA et al. was noted to merely disclose that by manual manipulation of keys, different parts of a document can be printed. However, it was pointed out that FUJITA et al. contains no teaching regarding printing either an entire e-mail data or a part of e-mail data in response to a determination, as recited in the claims.

At the conclusion of the interview, the Examiner agreed that the features recited in the claims are not taught or disclosed by the cited references. The Examiner further requested that Applicants arguments be included in the next Response to the outstanding Official Action. Applicants representative respectfully thanks the Examiner for his cooperation during the above-noted interview, for his cooperative approach and for his positive reaction to Applicants distinctions.

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Accordingly, Applicants respectfully request reconsideration of the outstanding rejections together with an indication of the allowability of all the claims pending in the present application.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have amended a claim to improve the language consistency thereof and have traversed the Examiner's rejections.

Applicants have discussed the disclosure of each of the references cited by the Examiner as well the combination of references and have pointed out the shortcomings and deficiencies thereof with respect to the claims in the present application. Applicants have further discussed the recitations of the claims and have pointed out how these features are not taught, disclosed nor rendered obvious by any proper combination of the cited references.

Applicants have further requested that the Examiner consider the Terminal Disclaimer previously filed as well as confirm consideration of the Information Disclosure Statements filed in the present application by return of the signed and initialed PTO-1449 Forms attached thereto.

Applicants have further made of record and confirmed the discussion during a telephone interview conducted in the present application during which the shortcomings and deficiencies of the rejections were pointed out to the Examiner. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully request an indication to such effect in due course.


Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art,

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should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Kyoji SAITO et al.



Bruce H. Bernstein
Reg. No. 29,027

William Pieprz
Reg. No. 33,630

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191